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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,376	02/08/2000	Sandra P. Chang	A-67984/RFT/DSS	2515

7590 11/13/2002
Flehr Hohbach Test Albritton & Herbert LLP
Four Embarcadero Center
Suite 3400
San Francisco, CA 94111-4187

EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 11/13/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/500,376

Applicant(s)
Chang et al

Examiner
Mark Navarro

Art Unit
1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1645

DETAILED ACTION

Applicant's response filed November 4, 2002 (Paper Number 16) has been received and entered. Consequently claims 37-55 remain pending in the instant application.

All grounds of rejection in the previous office action mailed July 2, 2002 are withdrawn.

The following new grounds of rejection are applied to the claims:

Claim Rejections - 35 USC § 112

1. Claims 37-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Claims 37-55 recite a composition comprising an isolated p42 protein or an isolated p42 fragment comprising the various amino acid fragments of SEQ ID NO: 2 through 5 .

The specification and claims do not indicate what distinguishing attributes are shared by the members of the genus. Thus, the scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. Since the disclosure fails to describe the common attributes or

Art Unit: 1645

characteristics that identify members of the genus, and because the genus is highly variant, SEQ ID NO: 2, 3, 4 and 5 alone are insufficient to describe the genus. Thus, Applicant's have not described a function which is shared by SEQ ID NO: 2, 3, 4, and 5 which would adequately describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus. It is further noted that SEQ ID NO: 2, 3, 4 and 5 are not full length proteins. Given that the function of the non-full length protein is not set forth, the written description of the instant application is supportive of only an antigenic peptide consisting of SEQ ID NO: 2, 3, 4 and 5, since additional amino acids on the N-terminus or C-terminus will have a profound impact on the activity of the protein.

Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. The protein itself is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Lts.*, 18 USPQ2d 1016.

Applicants are directed to the Revised Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement, Federal Register, Vol. 64, No. 244, pages 71427-71440, Tuesday December 21, 1999.

Art Unit: 1645

2. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is vague and indefinite in the recitation of “substantially reduces.” One of skill in the art would be unable to determine the metes and bounds of the claimed invention. For instance, what level of reduction is necessary in order to achieve “substantial reduction.” Similarly at what level of reduction is the reduction merely average reduction? Without a clear definition as to the metes and bounds of the term “substantially reduces” one of skill in the art would be unable to determine the metes and bounds of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being

Art Unit: 1645

examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

It is noted that Applicant's claim priority as a "continuation in part" to 08/195,705. However, the instantly filed claims (adjuvants QS-21 and ISA51) are only supported as of the filing date of the instant application, February 8, 2000. Consequently, Applicant's are only afforded priority to the instantly filed date of February 8, 2000.

3. Claims 37-47, 50 and 53-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Speaker et al.

The claims are directed to a pharmaceutical composition for treating plasmodium parasitemia in a mammal said composition comprising an isolated p42 polypeptide in combination with an adjuvant selected from the group consisting of QS-21 and ISA51 and mixtures thereof.

Speaker et al (U.S. Patent Number 6,270,800) disclose of vaccines comprising an isolated peptide antigen and the adjuvant QS-21. (See claims).

It is noted that Applicant's specification defines "p42 polypeptide" as a "polypeptide comprising a p42 amino acid sequence, including fragments and variants thereof, of the Plasmodium major merozoite surface protein (gp195)." (See page 8, lines 8-10).

Art Unit: 1645

The immunogenic peptide disclosed by Speaker et al is accordingly deemed to be a “variant” of the Plasmodium major merozoite surface protein (gp195), since no structural requirement is set forth in the recited claims.

Although the reference appears to disclose the same composition claimed by applicants, the reference does not disclose the composition produced by the claimed process. However the purification or production of a product by a particular process (e.g., recovery of the polypeptide from *Spodoptera*) does not impart novelty to a product when the product is taught by the prior art. This is particularly true when the properties of the product are not changed by the process in an unexpected manner.

See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972).

Therefore even if a particular process used to prepare a product is novel and unobvious over the prior art, the product per se, even when limited to the particular process, is unpatentable over the same product taught by the prior art.

See In re King, 107 F. 2d 618, 620, 43 USPQ 400, 402 (CCPA 1939); In re Merz, 97 F. 2d 599, 601, 38 USPQ 143-145 (CCPA 1938); In re Bergy, 563 F. 2d 1031, 1035, 195 USPQ 344, 348 (CCPA 1977) vacated 438 US 902 (1978); and United States v. Ciba-Geigy Corp., 508 F. Supp. 1157, 1171, 211 USPQ 529, 543 (DNJ 1979).

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro, whose telephone number is (703) 306-3225. The examiner can be reached on Monday - Thursday from 8:00 AM - 6:00 PM. The examiner can be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Lynette Smith can be reached at (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1645 by facsimile transmission. Papers should be faxed to Group 1645 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.



Mark Navarro

Primary Examiner

November 7, 2002